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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,632	07/11/2001	Darrell T. McKenzie	DANA-140	7898

23599 7590 06/23/2003

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EXAMINER

CECIL, TERRY K

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,632

Applicant(s)

MCKENZIE, DARRELL T.

Examiner

Mr. Terry K. Cecil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 17
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Objections

1. Claim 13 is objected to because of the following informalities: in line 5, "sealing portions" should be "sealing portion". Appropriate correction is required.

Claim Rejections - 35 USC ' 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is rejected because of the following reasons:

- Claim 18 depends from canceled claim 1 (for examination purposes, claim 18 is taken to depend from claim 13).
- The following terms lack antecedent basis: "the ribs"; "the skirt"; "the sealing lips" (claim 18).

Claim Rejections - 35 USC ' 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application

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filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 13, 14 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (U.S. 6,136,183). As shown in the figures, Suzuki discloses a flexible unitary valve body that includes a bypass collar portion 41 having an annular lip sealing portion 42 and projections (each of the portions forming groove 48) that support and sealing with protector 32 of the filter element. The valve body also includes a radially extending skirt 47 overlying inlet structure of the end plate [as in claims 13-14 and 19].

6. Claims 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmai (U.S. 3,669,144). As shown in the figures, Palmai teaches a unitary filter element support and valve (e.g. all the parts shown in figure 1 form a unit, applicant has not defined "unitary" otherwise in the specification) including a bypass portion 22 that includes sealing area 26 and ribbed projections 27, 28 that also extend over the radial antidrainback valve 23 and allow fluid pressure to be applied to the sealing portion [as in claims 13-16 and 18], wherein parts are made of rubber [as in claim 17] and the sealing flange 26 can be considered a "lip" [as in claim 19].

7. Claims 13-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by The British Reference (GB 1,450,395), hereinafter "395". 395 discloses a rubber unitary valve member 23 including an antidrainback portion 26 and a collar portion that seals with the filter element and forms a relief valve having projections (24 and the end opposite thereof) that allow fluid pressure to be applied to the member 23 (a pressure difference of the fluid pressures on

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both the pre-filt and filtrate sides cause the valve to open) [as in claims 13 and 14] wherein the projection can each be considered a "rib" [as in claim 15] and the area contacting the filter element a "lip" [as in claim 19].

8. Claims 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Buckman (U.S. 3,567,023). Buckman teaches a rubber valve body (figure 7) that includes a bypass portion having an annular sealing "lip" 24 and a radially extending antidrainback portion 21. The bypass portion also includes "rib projections" forming channels and a recess that supports 30 of the filter element and which extends over a portion of the antidrainback portion [as in claims 13-19].

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 13-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 09/965,805. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because claim 8 anticipates claims 13-19 of the instant application (it has been determined that anticipation is the epitome of obviousness). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Notes

11. After further consideration and in view of Buckman, the proposal for allowance on the attached interview summary is withdrawn.

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12. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (703)305-0079 for any inquiries concerning this communication or earlier communications from the examiner.
- The group receptionist can be reached at (703)308-0661 for inquiries of a general nature or those relating to the status of this or proceeding applications.
- Wanda Walker, the examiner's supervisor, can be reached at (703)308-0457 if attempts to reach the examiner are unsuccessful.
- Fax numbers for this art unit are as follows:
 - i. (703)872-9310 for *official* faxes (i.e. faxes to be entered as part of the file history) that are not after-final; and
 - ii. (703)872-9311 if after-final.

TKC
June 19, 2003

Examiner Terry K. Cecil